

REMARKS

Applicant would like to thank the Examiner for the courtesy extended to Applicant's representatives during the interview on July 1, 2004. The following reflects issues discussed during the interview.

Claims 1-166 are currently pending in this application. By this Amendment, Applicant has amended claims 1, 7, 57, 62, 111, and 117. More specifically, Applicant has amended claims 1, 7, 57, 62, 111, and 117 to positively recite that "the reservoir contains a product." Further, claims 1, 57, and 111 have been amended to positively recite that the product is "chosen from at least one of a skin product, a hair product, a toenail product, and/or a fingernail product." To the extent the claim rejections set forth in the Office Action dated April 6, 2004, may apply to the currently pending claims, those rejections should be withdrawn and the pending claims should be allowed for the reasons explained below.

In the Office Action, claims 1, 2, 6, 7, 10-15, 19, 24, 25, 29, 40-43, 45-57, 61, 62, 64-70, 74, 79-81, 84-86, 94-97, 99-112, 116, 117, 119-125, 129, 134-136, 139-141, 149-153, and 155-166 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,348,031 to Cloud. Applicants respectfully submit that this rejection should be withdrawn because Cloud fails to disclose every claim element. For example, independent claims 1, 7, 57, 62, 111, and 117 recite, among other things, that "the reservoir contains a product." As acknowledged by the Examiner in the Interview Summary, Cloud fails to disclose at least this subject matter, and therefore, the Section 102(b) rejection, of independent claims 1, 7, 57, 62, 111, and 117 and the claims depending therefrom should be withdrawn.

Further, independent claims 10, 65, and 120 recite that “the application element is made of a sintered material.” Cloud teaches several embodiments of an applicator (e.g., col. 3, lines 59-63 and col. 4, lines 19-33), but nowhere does Cloud explicitly or implicitly disclose an application element made of a sintered material.

It appears that the Office Action is relying upon the principle of inherency for the sintered material limitation. However, to establish inherency, the Examiner must show that “the missing descriptive matter is *necessarily* present” in the reference. See M.P.E.P. §2112 (*quoting In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. §2112 (emphasis in original.) In this case, the Office Action has failed to establish that there is any inherent disclosure of the sintered material limitation. Cloud lacks any disclosure of an application element that would necessarily be made of a sintered material. Therefore, Cloud neither explicitly nor inherently discloses an application element being “made of a sintered material.” For at least this reason, independent claims 10, 65, and 120, as well as their respective dependent claims, are patentably distinguishable from Cloud, and the Section 102(b) rejection based on Cloud should be withdrawn.

Also in the Office Action, claims 1-4, 6-9, 11, 13-33, 35-43, 45-59, 61-64, 66, 68-88, 90-97, 99-114, 116-119, 121, 123-143, 145-153, and 155-166 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,382,107 to Nian, and claims 1-9, 11-16, 19-21, 24-30, 32-64, 66, 68-71, 74-76, 79-119, 121, 123-127, 129-131, and 134-166 were rejected under either 35 U.S.C. § 102(b) or § 103(a) based on

U.S. Patent No. 3,741,667 to Cesari, either taken alone or in combination with U.S. Patent No. 4,056,110 to Landsman.

Cesari and Nian disclose toothbrushes that are used with toothpaste. Neither Cesari nor Nian discloses a device including a “reservoir [that] contains a product chosen from at least one of a skin product, a hair product, a toenail product and/or a fingernail product,” as recited in claims 1, 57, and 111. As discussed during the interview, one of ordinary skill in the art would not consider the toothpaste disclosed in those references as being a product as recited in claims 1, 57, and 111.

Further, Both Cesari and Nian fail to disclose a device including an “application element [that] is made of a compressible material,” as recited in claims 7, 62, and 117. In the Office Action, the Examiner took the position that the bristles forming the brushes of Nian and Cesari “can be compressed and thus the application element is deemed to be of a ‘compressible material.’” Office Action at 4. Applicant respectfully points out that there is nothing in either Nian or Cesari that provides any explicit or inherent teaching of an application element made of compressible material. For example, with regarding to the issue of inherency, even if the bristles of Nian and Cesari may be deformable, that would not necessarily provide any teaching of compressible material because not all deformable materials are necessarily compressible. Nowhere in either Nian or Cesari is there any disclosure of an application element made of compressible material.

For at least these reasons, claims 1, 7, 57, 62, 65, 111, and 117, and their respective dependent claims, are patentably distinguishable from Nian and Cesari,

whether taken alone or as applied in combination with Landsman. Accordingly, the various claim rejections based on these references should be withdrawn.

Claims 2-6, 8, 9, 11-56, 58-61, 63, 64, 66-110, 112-116, 118, 119, and 121-166 depend either directly or ultimately from independent claims 1, 7, 10, 57, 62, 65, 111, 117, and 120, respectively, and therefore are patentable for at least the same reasons each of these independent claims is allowable. In addition, at least some of these dependent claims recite unique features and combinations which are neither taught nor suggested by the cited art and therefore at least some also are separately patentable. Applicant respectfully requests the withdrawal of the outstanding rejections and the timely allowance of claims 1-166.


The Office Action contains various characterizations and assertions regarding Applicant's claims and the cited art with which Applicant does not necessarily agree. Regardless of whether Applicant has specifically addressed those characterizations and assertions, Applicant declines to subscribe to the same.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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